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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/871,199 | 05/31/2001 | James M. Kain | 20341-67618 | 9889 |

7590 02/22/2007
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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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3636

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 2 MONTHS | 02/22/2007 | PAPER |

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/871,199
Filing Date: May 31, 2001
Appellant(s): KAIN, JAMES M.

Richard B. Lazarus
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 25 October 2006 appealing from the Office action mailed 18 May 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 35 U.S.C. 103(a) rejection of claims 11, 12, and 27-29 as being unpatentable over Markel has been withdrawn. The 35 U.S.C. 103(a) rejection of claims 4 and 31 as being unpatentable over Lemmeyer et al., as modified, in view of Deloustal has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|-----------------|---------|
| 6,478,372-B1 | LEMMEYER et al. | 11-2002 |
| D 284,889 | MARRUJO | 05-1980 |
| 207,764 | MITCHELL | 09-1878 |
| 5,297,851 | VAN HEKKEN | 03-1994 |
| 4,274,674 | DELOUSTAL | 06-1981 |
| 5,316,373 | MARKEL | 05-1994 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-9, 11, 12, 25, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmeyer et al. in view of Marrujo. Claims 13, 14, and 26 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmeyer et al. in view of Marrujo as applied to claims 6-9, 11, 12, 25, and 27-29 above, and further in view of Mitchell. Claims 5 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemmeyer et al. in view of Marrujo as applied to claims 6-9, 11, 12, 25, and 27-29, and further in view of Van Hekken. These rejections are set forth in the Office Action mailed on 18 May 2006.

(10) Response to Argument

- I. 35 U.S.C. 103(a) rejection of claims 6-9, 11-12, 25, and 27-29 as being unpatentable over Lemmeyer et al. in view of Marrujo should be maintained**
 - A. Independent claim 6 has been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo**

Appellant argues that the modification of Lemmeyer et al. in view of Marrujo is improper because (1) the modification would change the principle of operation of the armrest of Lemmeyer et al., and (2) there is no motivation to combine the references. Initially, it is noted that Appellant concedes that Lemmeyer et al. teaches a juvenile vehicle seat assembly having a seat 10 (see Fig. 2) with a seat bottom 14 and a seat back 12, a cantilevered armrest 16 projecting from the seat back, a support mount of the armrest 19 (see Fig. 1B) with inner and outer flanges forming a U-shaped channel to receive a ridge of the seat back, and a first fastener received within aperture 120. With respect to Marrujo, Appellant concedes that Marrujo teaches a support mount for use in a chair that includes inner and outer flanges (see Figs. 1 & 4) adapted to receive outwardly arranged fasteners.

i. **The combination of Lemmeyer et al. in view of Marrujo does not change the principle of operation of Lemmeyer et al.'s armrest**

Appellant asserts that modifying the support mount of Lemmeyer et al. to have the first fastener arranged to lie above the arm, as taught by Marrujo, would change the principle of operation of Lemmeyer et al.'s armrest because the abutment of the arm's top surface 106 with the upper shelf 114 would be removed. Appellant's argument is premised on the fact Lemmeyer et al. mention that "the top and bottom surfaces 104, 106 . . . of the armrest 16 abut upper and lower shelves 112, 114 . . ." (see column 5, line 65 to column 6, line 15). However, Appellant's argument is unpersuasive because Lemmeyer et al. contemplate alternate attachments of the armrest to the backrest, and because the support mount configuration of Marrujo would not change the abutment operation of Lemmeyer et al.

The abutment of Lemmeyer et al.'s arm with the upper shelf is not the principle of operation of the armrest because Lemmeyer et al. specifically contemplate multiple configurations for the attachment of the armrest to the seat back. Lemmeyer et al. describe the arm attachment by stating:

It will be understood by those skilled in the art that the tongue-in-groove attachment is one among many that may provide a rigid attachment between a first mounting surface of a cantilever armrest and a second mounting surface on a backrest. ***This invention contemplates alternative embodiments*** that employ a first mounting surface and a second mounting surface to attach the cantilever armrests to the backrest. For example, the connection between the armrest and the backrest may be accomplished by an interleaved arrangement, where the first end 19 of the cantilever armrest 16 includes plural fins that interleave with fins molded at an appropriate location into the forward facing surface 118 of the backrest. ***Alternatively***, the grooved first end 19 of the armrest 16 may be replaced by a single tab-like extension that may be rigidly

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attached to either side surface the tongue 110, i.e., a lap joint. **Further**, the first end 19 of the armrest 16 may be formed with a rounded protuberance adapted to be inserted into a socket in the forward facing surface 118 of the backrest. **As a further alternative** to the above described methods of attaching the cantilever armrests to the backrest, the armrests 16 may be attached to the backrest 12 by being integrally molded therewith. (column 6, lines 18-39) (emphasis added)

The support mount of Marrujo is one such alternate attachment configuration. Because Lemmeyer et al. contemplate multiple attachment configurations not employing the top surface abutting the upper shelf, it is clear that the recited abutment of the top surface 106 with the upper shelf 112 is not the principle of operation of Lemmeyer et al.'s armrest.

Assuming arrguendo that the recited abutment of the top surface 106 with the upper shelf 112 was the principle of operation of Lemmeyer et al.'s armrest, the combination of Lemmeyer et al. in view of Marrujo would not undermine this principle of operation. Modifying the support mount of Lemmeyer et al. to include an upper wing, as taught by Marrujo, would still provide a continuous flat surface for abutting the inner and outer edges of the upper shelf. Appellant's assertion that the armrest of Lemmeyer et al. in view of Marrujo would be less rigid is unsubstantiated by any evidence, and it appears that the armrest of the combination would satisfy the principle of operation of Lemmeyer et al.'s armrest.

ii. Motivation to combine the teachings of Lemmeyer et al. in view of Marrujo arises from the knowledge generally available to one of ordinary skill in the art

Appellant argues that there is no teaching or suggestion in the prior art that would have motivated one of ordinary skill in the art to modify the armrest of Lemmeyer

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et al. in view of Marrujo wherein any such motivation arises from improper hindsight reasoning. However, Appellant has neglected to acknowledge that a prima facie case of obvious is also established by some suggestion or motivation in the knowledge generally available to one of ordinary skill in the art to combine reference teachings. See MPEP §§ 706.02(j), 2143.01. Appellant concedes that such a motivation existed within the knowledge generally available to one of ordinary skill regarding the claimed armrest attachment configuration.

One of ordinary skill in the art would have modified the support mount of Lemmeyer et al. based on the teachings in Marrujo, the knowledge generally available to one ordinary skill in the art, and the desirability of the support mount configuration. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1217 (Fed. Cir. 2000). As previously recited, Lemmeyer et al. specifically contemplate various configurations to attach the armrest to the seat back (see column 6, lines 18-39). For example, Lemmeyer et al. contemplate a dovetail-type configuration wherein fins of the armrest interleave with fins in the backrest, a lap joint configuration with a tab attached to the tongue 110, or a rounded protuberance configuration insertable into a backrest socket. While Lemmeyer et al. does not mention the attachment configuration recited in claim 6, this attachment configuration is generally available to one of ordinary skill in the art. See Figures 1-5 of Marrujo for the teaching that a support mount in the chair art may include a first fastener arranged to lie above the surface of a cantilevered arm member.

Appellant concedes that upper wings of an armrest support mount including the first fastener arranged to lie above the arm is generally available to one of ordinary skill

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in the art. In discussing the rejection of claim 7, Appellant states that "one of ordinary skill in the art would understand . . . the purpose of the claimed flanges" (see page 7, lines 16-17 of the Appeal Brief). These flanges house the first fastener arranged to lie above the arm. From Appellant's statements, it is clear that one of ordinary skill in the art generally possesses the knowledge regarding the purpose of having a fastener arranged to lie above the arm when a rigid cantilevered armrests is desired.

One of ordinary skill in the art would be motivated by the teachings of Marrujo and by the knowledge that is generally available because the support configuration with the first fastener above the arm would simplify manufacture. The support mount having a first fastener arranged to lie above the arm would allow Lemmeyer's armrest configuration to be manufactured without cutting out portions of each forward facing surface 118 of the backrest to form the tongue 110 and shelves 112, 114. This simplification in manufacturing suggests the desirability, and thus the obviousness, of making the combination of Lemmeyer et al. in view of Marrujo. See In re Fulton, 391 F.3d 1195, 1200-01 73 USPQ2d 1141, 1145-46 (Fed Cir. 2004) (holding teachings in a design patent established desirability of claimed configuration such that combination was obvious to one of ordinary skill).

Appellant states that the combination of Lemmeyer et al. in view of Marrujo would be undesirable because the armrest of the combination would provide a support for the user's arm at a lower level. However, Lemmeyer et al. does not disclose that the level of arm support is a desirable aspect of the invention. Moreover, Appellant's argument

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is based on the references individually. The desirability should be evaluated on the combination as a whole. Id.

Because (1) the prior art teaches cantilevered armrests and support mounts with first fasteners arranged to lie above the arms, (2) the motivation to have the recited support mount configuration is knowledge generally available to one of ordinary skill in the art, and (3) the desirability of the configuration would have been suggested to one of ordinary skill in the art, the rejection of claim 6 as being unpatentable over Lemmeyer et al. in view of Marrujo is based on a proper prima facie case of obviousness.

B. Dependent claims 7 and 8 have been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo

Appellant argues that the combination of Lemmeyer et al. in view of Marrujo does not teach the recited upper wing of each flange because the orientation of Marrujo is not horizontal. This argument is unpersuasive because Marrujo does not limit the support mount's to a horizontal orientation and the references should not be evaluated individually. Marrujo teaches wings of the support mount may be positioned away from the arm surface wherein the orientation of the arm is irrelevant to this teaching. In addition, it has been established that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See the above arguments establishing the motivation to combine the teachings of Lemmeyer et al. and Marrujo.

C. Dependent claim 9 has been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo

Appellant argues that the combination of Lemmeyer et al. in view of Marrujo does not teach the recited lower wing of each flange because the orientation of Marrujo is not horizontal. This argument is unpersuasive for reasons set forth above. See the above arguments establishing the motivation to combine the teachings of Lemmeyer et al. and Marrujo.

D. Independent claim 11 has been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo

Appellant argues that the combination of Lemmeyer et al. in view of Marrujo does not teach the recited fastener above the arm. This argument is unpersuasive for reasons set forth above. See the above arguments establishing the motivation to combine the teachings of Lemmeyer et al. and Marrujo.

E. Independent claim 12 has been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo

Appellant argues that the combination of Lemmeyer et al. in view of Marrujo does not teach the recited fastener above the arm. This argument is unpersuasive for reasons set forth above. See the above arguments establishing the motivation to combine the teachings of Lemmeyer et al. and Marrujo.

F. Independent claim 25 has been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo

Appellant argues that the combination of Lemmeyer et al. in view of Marrujo does not teach the recited means for fastening the support mount to the seat back. This argument is unpersuasive for reasons set forth above. See the above arguments

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establishing the motivation to combine the teachings of Lemmeyer et al. and Marrujo.

The combination teaches the corresponding structure described in the instant application, or, alternatively, an equivalent thereof.

G. Claims 27-29 have been properly rejected as being unpatentable over Lemmeyer et al. in view of Marrujo

Appellant argues that the combination of Lemmeyer et al. in view of Marrujo does not teach the recited upper and lower wings with fasteners. This argument is unpersuasive for reasons set forth above. See the above arguments establishing the motivation to combine the teachings of Lemmeyer et al. and Marrujo.

II. 35 U.S.C. 103(a) rejection of claims 11, 12, and 27-29 in view of Markel has been withdrawn

The rejection of claims 11, 12, and 27-29 as being unpatentable over Markel has been withdrawn.

III. 35 U.S.C. 103(a) rejection of claims 13, 14, and 26 as being unpatentable Lemmeyer et al. in view of Marrujo as applied above, and in further view of Mitchell should be maintained

Appellant argues that the combination of Lemmeyer et al., as modified, in view of Mitchell because there is no motivation to make a notch in the seatback of Lemmeyer et al. As a preliminary matter, it is uncontested that Mitchell teaches a seat assembly having a seatback A,E (see Fig. 1), a cantilevered armrest J with a support mount and load support panel (see column 2, lines 31-37).

Appellant's argument is unpersuasive because the teachings of Mitchell provide proper motivation to further modify the armrest of Lemmeyer et al. Mitchell teaches that the armrest J, including the specified support mount configuration, provides a durable

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and neat design (column 1, line 22-32) having an armrest flush with the exterior of the backrest. The support mount configuration of Mitchell accomplishes this desirable, and thus obvious, combination by utilizing a dovetail configuration wherein the support mount's load support panel (i.e. the shoulder in column 2, lines 31-32) rests against the notched surface of the backrest thereby strengthening the armrest and backrest. Mitchell's load support panel ensures that the armrest configuration is both flush with the exterior of the backrest and just as strong as a traditional armrest projecting from the side of a backrest.

Appellant argues that there is no motivation to combine the references because one of ordinary skill would not make a notch in the tongue 110 of Lemmeyer et al. However, tongue 110 of Lemmeyer et al. is in fact formed by a notch being cut into the forward facing surface 118 of the backrest. Therefore, Appellant's argument is without merit because no notch would need to be cut into the tongue 110. Moreover, Appellant is again arguing against the references individually wherein one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Herein, it would have been obvious to one of ordinary skill in the art to modify the combination of Lemmeyer et al. in view of Marrujo to have an armrest that is flush with the exterior of the backrest, such as the armrest disclosed by Mitchell. In making such a modification, one of ordinary skill would have been motivated to include a load support panel in the armrest.

In addition, Appellant argues that there is not teaching of a load support panel in armrest of Lemmeyer et al. in view of Marrujo. However, this argument does appear

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particularly relevant because Examiner relies on Mitchell's teachings of the load support panel in order to modify the armrest of Lemmeyer et al. If the armrest of Lemmeyer et al. in view of Marrujo taught a load support panel, then there would not need to reference the teachings of Mitchell. See the above analysis as to why one of ordinary skill in the art would have been motivated to further modify the armrest of Lemmeyer et al. to include a load support panel, such as the armrest disclosed by Mitchell.

For reasons given above, the rejection of claims 13, 14, and 26 should be maintained.

IV. 35 U.S.C. 103(a) rejection of claims 4 and 31 as being unpatentable over Lemmeyer et al. in view of Marrujo as applied above, and further view of Deloustal, has been withdrawn

The rejection of claims 4 and 31 as being unpatentable over Lemmeyer et al. in view of Marrujo as applied to claims 6-9, 11, 12, 25, and 27-29, and further in view of Deloustal, has been withdrawn.

V. 35 U.S.C. 103(a) rejection of claims 5 and 30 as being unpatentable over Lemmeyer et al. in view of Marrujo as applied above, and in further view of Van Hekken should be maintained

Appellant argues the 35 USC 103(a) rejection of claims 5 and 30 should be withdrawn because the combination of Lemmeyer et al. in view of Marrujo is improper. Because the combination of Lemmeyer et al. in view of Marrujo is proper for reasons set forth above, the rejection of claims 5 and 30 should be maintained.

VI. Conclusion

For reasons set forth above, the rejections of claims 5-9, 11-14, and 25-30 should be maintained.

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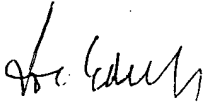
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joe Edell



Conferees:

Rodney White 

Meredith Petravick 